

Remarks

Claims:

Claims 1, 3-12, and 14-29 are pending in the application. Dependent claims 21-29 are newly presented.

Double-Patenting Rejections:

Claims 1, 3-12 and 14-21 are *provisionally* rejected over assignee's U.S. Patent Application No. 10/326,575.

A *provisional* double patenting rejection is not a bar to issuance.

For example, see the Manual of Patent Examining Procedure (MPEP) at 822.01, under the section titled: ONLY PROVISIONAL DOUBLE PATENTING REJECTION REMAINING IN ONE APPLICATION: "*If the "provisional" double patenting rejection in one application is the only rejection remaining in that application, the examiner should then withdraw that rejection and permit the application to issue as a patent. . . .*"

We respectfully request that the Examiner withdraw this *provisional* double patenting rejection and pass the application along to issuance.

Art-Based Rejections:

Claims 1, 3-12 and 14-21 are rejected as being anticipated by U.S. Patent No. 5,604,802 ("Holloway").

We respectfully traverse these rejections.

Claim 1

It is well settled that in order for an Examiner to establish a *prima facie* case of anticipation, each and every element of the claimed invention, arranged as required by the claim, must be found in a single prior art reference, either expressly or under the principles of inherency. See generally, *In re Schreiber*, 128 F.3d 1473, 1477 (Fed. Cir. 1997); *Diversitech Corp. v. Century Steps, Inc.*, 850 F.2d 675, 677-78 (Fed. Cir. 1988); and *Lindemann Maschinenfabrik GMBH v. American Hoist and Derrick*, 730 F.2d 1452, 1458 (Fed. Cir. 1984).

Holloway does not anticipate claim 1 because it does not include – either expressly or inherently – at least employing the authentication information reader to recover the *embedded* first authentication information. Recall that a digital representation of an object includes the *embedded* first authentication information.

The Office Action apparently cites to Holloway’s Abstract for these features. See the Office Action, page 5, lines 9-15. The Abstract is reproduced below for the Examiner’s convenience:

A transaction processing system comprises at least one transaction terminal (10, 11, 12) having means to receive characteristic data from a user, which characteristic data is required to generate a characteristic image associated with the user, such as an image of the user's signature, from data stored in a data processing system (14); and logic for generating a transaction message by combining transaction data with the characteristic data in such a way that the transaction data is required to recover the characteristic data from the message. The data processing system (14) comprises means to store the user data, to receive and store the message, to recover the characteristic data from the message using the transaction data, and to reconstruct the characteristic image from the user data using the characteristic data to establish that the transaction was valid by associating the characteristic image with the transaction data.

Holloway’s Abstract does not have – either expressly or inherently – at least employing an authentication information reader to recover *embedded* first authentication information. In fact, we do not even see the word “embedded” included in the Abstract.

Thus, Holloway fails to anticipate claim 1.

Claims 18 and 20

Claims 18 and 20 should be allowed for reasons that are analogous to those discussed above with respect to claim 1.

Claim 11

Holloway does not have each and every element of claim 11, arranged as required by the claim, either expressly or under the principles of inherency.

For example, Claim 11 recites that the embedded first authentication information is a cryptographic hash *embedded as a watermark* in a graphic on or in the analog form.

None of the cited Holloway passages (i.e., Col. 2, line 19-26; Fig. 3, item 515 (“smart card”), Fig. 1, item 503c (“generate MDC”); Col. 3, lines 2-8; and the Abstract; see the Office Action, page 5, lines 9-15) have these features.

Claim 11 should be allowed.

Claims 3 and 15

Claim 3 recites – in combination with other features – a key is stored in a storage system and associated with a reference code; and a processor further employs the reference code to retrieve the key; and an authentication information reader uses the key to read the first authentication information.

We see no discussion of these features in the Office Action. See the Office Action, page 5, last paragraph. We are left to guess how Holloway is intended to be directed toward these features. And guessing denies us an opportunity to respond on the record.

Such a rejection is contrary to the guidance provided by the MPEP (see, e.g., MPEP 706.02(j)). For example: “[T]he examiner should set forth in the Office action: (A) the relevant teachings of the prior art relied upon, preferably with reference to the relevant column or page number(s) and line number(s) where appropriate....” See MPEP 706.02(j). This is because “[i]t is important for an examiner to properly communicate the basis for a rejection so that the issues can be identified early and the applicant can be given fair opportunity to reply.” See MPEP 706.02(j).

Moreover, Holloway is not understood to have each and every one of these elements, arranged as required by the claim, either expressly or under the principles of inherency.

Claim 15 further recites a verification system employing a reference code to locate a key that is required to read the first authentication information.

Again, we see no discussion of these features in the Office Action. See the Office Action, page 5, last paragraph.

And Holloway is not understood to have each and every one of these elements, arranged as required by the claim, either expressly or under the principles of inherency.

Thus, the Office Action fails to establish a *prima facie* case of anticipation.

Claims 3 and 15 stand ready for allowance over Holloway.

Claims 14 and 17

Claims 14 and 17 recite “*steganographically embedded*” first authentication information, variously in combination with many other features. As one of ordinary skill in the art will appreciate, the term “steganography” implies hidden information or imperceptibility.

While Holloway may store reference data related to biometric information on a smart card (see Col. 5, lines 39-44), he does not do so in a steganographically embedded manner.

These claims stand ready for allowance over Holloway.

Remaining claims

Favorable reconsideration of the remaining claims is respectfully requested.

Conclusion:

The Examiner is invited to contact the undersigned with any questions.

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Respectfully submitted,

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